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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT W. BOSSEMEYER JR.,
EDMOND W. ISREALSKI,
JORDAN HOWARD LIGHT,
DENISE VIOLETTA KAGAN,
JOSE M. CRUZ,
BRUCE EDWARD STUCKMAN,
RAYMOND WALDEN BENNETT III,
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BARRY JAMES SULLIVAN,
RICHARD PETER KRUPKA, and
PHILIP MARTIN STEBBINGS

Appeal 2008-2701
Application 09/407,126
Technology Center 3600

| Decided:¹ March 19, 2009

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
BIBHU R. MOHANTY, *Administrative Patent Judges.*

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

LORIN, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Robert W. Bossemeyer Jr., et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-3, 5-12, 14-19, and 21-30. Claims 4, 13, and 20 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.²

THE INVENTION

The “invention relates to methods, systems, and articles for determining an availability of a telecommunication feature.” Specification 1:6-8. “To determine the availability of a product and/or a service, a customer may call a marketing representative of a telecommunication service provider. If the product and/or service is unavailable to the customer, the marketing representative informs the customer of same. The marketing representative may make a record of the call by writing a name

² Our decision will make reference to Appellants’ Appeal Brief (“App. Br.,” filed May 24, 2007) and Reply Brief (“Reply Br.,” filed Sep. 27, 2007), and the Examiner’s Answer (“Answer,” mailed Sep. 6, 2007).

and a telephone number of the customer who inquires about an unavailable product or service.” Specification 1:22-2:2. “To inform a customer of the availability of a previously-unavailable product or service, a follow-up call to the customer may be made based on the aforementioned written record.

However, this process is a manual process prone to delays and errors.”

Specification 2:3-7. To overcome this problem, “the present invention provides a return call marketing tool.” Specification 2:24-26.

An interface is provided to capture individual customer interest in telecommunication features. A database responsive to the interface stores information for a plurality of customers’ interest[s]. A computer receives input which tracks the availability of features, and creates an action when a customer need can be fulfilled. The action can be easily followed-up by a sales or service representative to assist in making a sale to a customer. Using this tool, a telecommunication service provider can become more responsive to their customers’ wants and needs.”

Specification 2:26-2:7.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method comprising:
 - inquiring in a first transaction about a first telecommunication feature unavailable to a first party of a telecommunication network;
 - in accordance with the inquiring in the first transaction, storing a first data structure which identifies the first party of the telecommunication network and the first telecommunication feature unavailable to the first party;
 - after storing the first data structure, and after

completion of the first transaction, upgrading a portion of the telecommunication network which serves the first party;

in accordance with upgrading the portion of the telecommunication network which serves the first party, inputting availability data which indicates an availability of the first telecommunication feature to the portion of the telecommunication network which serves the first party;

in response to upgrading the portion of the telecommunication network which serves the first party, processing the first data structure and the availability data to determine that the first telecommunication feature has become available to the first party; and

placing a call to the first party to inform the first party that the first telecommunication feature has become available, wherein placing the call to inform the first party that the first telecommunication feature has become available occurs before the first party has subscribed to the first telecommunication feature, wherein the placing of the call to the first party occurs in response to the inquiring in the first transaction, the upgrading the portion of the telecommunication network, and the processing of the first data structure and the availability data, wherein the first party has the opportunity to subscribe to the first telecommunication feature after the call is placed.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Majmudar	US 4,897,866	Jan. 30, 1990
Alcott	US 6,324,273 BI	Nov. 27, 2001

The following rejection is before us for review:

1. Claims 1-3, 5-12, 14-19, and 21-30 are rejected under 35 U.S.C. §103(a) as being unpatentable over Alcott and Majmudar.

ISSUES

The first issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 1-3, 5-12, 14-19, and 21-30 under 35 U.S.C. §103(a) as being unpatentable over Alcott and Majmudar. The issue turns on whether Majmudar discloses the claim step of “placing a call to the first party to inform the first party that the first telecommunication feature has become available, ..., wherein the placing of the call to the first party occurs in response to the inquiring in the first transaction, the upgrading the portion of the telecommunication network, and the processing of the first data structure and the availability data ...” claim 1.

PRINCIPLES OF LAW

Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). See also *KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”) The Court in Graham further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

ANALYSIS

Claims 1 and 9 are drawn to methods comprising steps of inquiring about an unavailable telecommunication feature, storing data identifying the inquiring party and the unavailable feature, upgrading the telecommunication network so that the availability of the feature is indicated, processing the data to determine that the feature is available, and placing a call to the inquiring party that the feature is available before the party subscribes to the feature.

Alcott is directed to a process by which customers can order subscription telecommunication service products, e.g., a caller identification

service (col. 2, l. 23), using touchtone keys. (col. 1, ll. 62-65.) The processing of the order involves “a step of determining an availability of the telecommunication service” (col. 3, ll. 62-63). According to Alcott, if the telecommunication service is unavailable, a step of communicating a written correspondence to the originating party 12 is performed, as indicated by block 74. The written correspondence indicates that the telecommunication service is not being provided to the originating party 12 due to unavailability (col. 4, ll. 45-50). Alcott further discloses a menu mode which a customer can activate from their telephone (col. 5, ll. 4-6), which menu may provide a plurality of telecommunications options (col. 5, ll. 29-31) such as an automatic call back feature (col. 5, l. 59; col. 6, ll. 10-12). Alcott does not explain the purpose of this call back feature. We note that the Examiner pointed to col. 5, ll. 53-60 as teaching “that said informing [of the availability of a feature] is implemented ... via initiating an automatic call back.” Answer 4. We do not read that passage as saying that. It appears to describe various telecommunication options which can be accessed by pressing specific buttons on a telephone.

Alcott does not disclose the claim limitations involving placing a call to the inquiring party that the feature is available after the telecommunications package has been upgraded and before the party subscribes to the feature. As the Examiner has stated, Alcott “does not explicitly teach that said “inputting” step and “informing/placing a call” step are occurring after completion of the first transaction and after upgrading the portion of the telecommunication network which serves the party.”

Answer 4. The Appellants agree. “The Office Action correctly states that Alcott does not teach at least informing the first party that a previously

unavailable telecommunications feature has become available, wherein the informing occurs in response to the upgrading the portion of the communication network and the processing of the first data structure and the availability data.” App. Br. 7.

The Examiner relied on Majmudar for disclosure of the “inputting” and “informing/placing a call” steps. According to the Examiner,

Majmudar teaches a computer-implemented method and system for providing a telecommunication service to a subscriber, wherein, after the subscriber selects (inquires) a desired specific telecommunication feature, the inquiry is processed, and appropriate software modules are assembled (the system is upgraded) to enable the requested feature. After this event (indicates after completion of the first transaction), if user lifts a handset to originate a call, the terminal will display the requested new feature (indicates informing the first party that the first telecommunication feature has become available, where said “informing” occurs in response to the upgrading the portion of the communication network and the processing of the first data structure and the availability data), and wherein said “informing” occurs before the first party has subscribed (utilized said feature and billed for, C. 5, L. 67) to the first telecommunication feature.” (Abstract; C. 6, L. 1-17).

Answer 4.

Given Alcott and Majmudar, the Examiner determined that “[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Alcott to include that ... informing the first party that the first telecommunication feature has become available, as taught by Majmudar, because it would advantageously allow to

accommodate various needs subscribers may have; and to improve customer service by allowing subscribers to inquire for the desired feature only once.”

Answer 4-5.

The Appellants disagree with the Examiner’s understanding of what Majmudar discloses, finding that Majmudar does not in fact disclose the limitation the Examiner determined to be missing from Alcott. *See* App. Br. 7 and Reply Br. 2-3. Accordingly, the Appellants concomitantly challenge the obviousness determination. According to the Appellants, the “system of Majmudar et al. is an arrangement for allowing a subscriber to select from telephone features that are available, not unavailable, to the subscriber.” Reply Br. 2.

At issue is whether Majmudar discloses the claim step of “placing a call to the first party to inform the first party that the first telecommunication feature has become available, . . . , wherein the placing of the call to the first party occurs in response to the inquiring in the first transaction, the upgrading the portion of the telecommunication network, and the processing of the first data structure and the availability data . . . ” claim 1.

We have carefully reviewed Majmudar. We agree with the Appellants that Majmudar shows providing a subscriber a selection of telephone features that are available, not unavailable. This is evident from the discussion at col. 5, ll. 45-54: “. . . to cause the terminal to display the feature selection panel stored in the terminal. This display panel will include appropriate add boxes with available unsubscribed features and delete boxes with currently subscribed features. . . .” We have reviewed the Abstract, col. 5, l. 67, and col. 6, ll. 1-17, the passages in Majmudar the Examiner relied on, but do not find there any mention of selecting “unavailable” telephone

features. The claim requires placing a call to inform a party that a telecommunication feature has become available, the call occurring before the party has subscribed to the telecommunication feature, and where the placing of the call to the party occurs in response to inquiring about a telecommunication feature “unavailable” to the party. Because Majmudar shows a party selecting available rather than an *unavailable* telephone feature, the Examiner’s contention that Majmudar shows the step at issue is inaccurate.

We note that the Examiner argued that Majmudar “explicitly teaches that the terminal has to be upgraded before the subscriber is able to utilize the selected feature ([col. 6, ll. 8-17]). If the new terminal package reflecting the updated feature is not loaded into the terminal, the subscriber is not able to utilize the selected feature, and, as such, said new feature is unavailable to the subscriber.” Answer 9. The difficulty with this argument is that Majmudar clearly indicates that the unsubscribed features one may add are “available” features. One of ordinary skill in the art reading Majmudar would understand it to describe upgrading with features that may not have been utilizable prior to the upgrade (because they unsubscribed) but were nevertheless “available” for selection. The claim on the other hand calls for upgrading the telecommunication network and “inputting availability data which indicates an *availability* of the first telecommunication feature to the portion of the telecommunication network which serves the first party.” Majmudar does not disclose inputting availability data which indicates an availability of the inquired but unavailable feature. What Majmudar discloses is upgrading the terminal package so that it corresponds to those “available” features which have been

selected and subscribed for. Majmudar would have no reason to indicate an *availability* of a feature since all the features which could be subscribed for are already indicated as available for subscription.

The factual inquiry as to the scope and content of the prior art leads to the conclusion that neither Alcott nor Majmudar discloses the “inputting” and “informing/placing a call” steps of the claimed method. Given this, we conclude that a *prima facie* case of obviousness has not been established.

The two remaining independent claims, claims 10 and 17, define apparatus and computer-readable medium counterparts to the claim 1 method and were rejected using the same reasoning used to reject claim 1. For the same reasons, we conclude that the Examiner has not made out a *prima facie* case of obviousness.

CONCLUSIONS OF LAW

We conclude that the Appellants have shown that the Examiner erred in rejecting claims 1-3, 5-12, 14-19, and 21-30 under 35 U.S.C. §103(a) as being unpatentable over Alcott and Majmudar.

DECISION

The decision of the Examiner to reject claims 1-3, 6-12, 14-19, and 21-30 is reversed.

Appeal 2008-2701
Application 09/407,126

REVERSED

LV:

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